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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,223	06/03/2005	Matti Halkosaari	P17714-US1	3425

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ERICSSON INC.
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PLANO, TX 75024

EXAMINER

TIEU, BINH KIEN

ART UNIT	PAPER NUMBER
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2614

MAIL DATE	DELIVERY MODE
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07/27/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/537,223

Applicant(s)

HALKOSAARI, MATTI

Examiner

/BINH K. TIEU/

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 14-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/9/06&6/3/05</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Response to Preliminary Amendment

1. The Applicant's preliminary amendment filed on 06/03/2005 was entered. As the results, the original PCT claims 1-13 were cancelled, and new claims 14-23 had been added. Therefore, claims 14-23 are pending in this application at this point.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claim 23 is rejected under 35 U.S.C. 102(e) as being anticipated by Koskinen et al. (Pub. No.: us 2005/0271193).

Regarding claim 23, Koskinen et al. ("Koskinen") teaches a Session Initiation Protocol (SIP) server for use in an IP Multimedia Core Network Subsystem of a communications system, the server comprising:

means for causing SIP signaling, associated with a cost sharing negotiation between two or more user terminals coupled to the system, to be diverted through the server; and,

means for extracting agreed cost sharing data from the diverted signaling, and means for either allocating costs to one or more of the terminal users in accordance with this data or for providing information to another system node to allow that node to allocate costs (see paragraphs [0047] through [0057]).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 14-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Andreas et al. (WO 2002/052832 A) *as cited in the International Preliminary Examination Report* in view of Koskinen et al. (Pub. No.: us 2005/0271193).

Regarding claim 14, Andreas et al. ("Andreas") teaches a method of negotiating a cost sharing formula associated with a communications service between a plurality of participants (see page 3, 2nd paragraph, in combination with page 1, 2nd paragraph)

- sending a message from a terminal used by a first of the participants to terminals, used by the or each other participants containing a cost sharing request (see in particular page 3, 3rd paragraph); and

- at the or each other terminal receiving said message, processing the request using predefined cost sharing rules and/or receiving user inputs relating to the request (see page 3, 3rd paragraph), and sending a response message to first participant's terminal containing a result,

(see page 3, 3rd paragraph),

- the participants being charged by the network(s) (see page 5, 2nd. paragraph) in accordance with the formula.

It should be noticed that Andreas fails to clearly teach the features of:

- a) the method is based upon the Session Initiation-Protocol (SIP), and
- b) the step of configuring one or more-Session Initiation Protocol servers to intercept Session Initiation Protocol messages for the purpose of determining the negotiated cost sharing formula.

However, Koskinen et al. ("Koskinen") teaches such features in paragraphs [0037]-[0038], [0040]-[0041] and [0047] through [0057].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of the features of a). and b). above, as taught by Koskinen into view of Andreas in order to provide the actual determined charge towards each party.

Regarding claims 21 and 23, the same considerations as made for claim 1 above are also valid for independent claims 21 and 23, since these claims include the similar feature combination as claim 1 in terms of the corresponding *terminal apparatus* claim (claim 21) and the corresponding *server apparatus* claim (claim 23)

Regarding claim 15-20, Andreas further teaches the limitations of the claims as followings:

For claim 15, either calling or called party is permitted to start the service for reverse charging, the invocation principle being obviously also applicable for the negotiation: see page 3,

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line 26 to page 4, line 12 and page 6, lines 1 to 7, represents simple design details which are generally known to the person skilled in the field of Multimedia services and its related charging.

For claim 16, response to cost sharing proposal,: see page 3, 3rd paragraph.

For claim 17, receiving terminal, proposes alternative or modified cost proposal: see page 6, 3rd paragraph.

For claim 18," three or more participants: implied by page 1, 2nd paragraph, and page 6, 2nd paragraph "bilateraler oder multilateraler Abkommen".

For claim 19, time of negotiation: see page. 3, 2nd paragraph; for claim 7: 3GPP IP Multimedia Subsystem: implied by. Page 1., 2nd paragraph "Multimedia Session".

For claim 20, a mobile wireless terminal being implied by the 3GPP standard.

regarding claim 22, Andreas further teaches limitations of the claim in paragraph [0032]

6. Claims 14-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Andreas et al. (WO 2002/052832 A) or Erisson Telefon AB LM (WO 00/38403 A) (hereinafter “’403”), *as cited in the International Preliminary Examination Report*) in view of Brown et al. (Pub. No.: us 2003/0114142).

Regarding claim 14, Andreas et al. (“Andreas”) teaches a method of negotiating a cost sharing formula associated with a communications service between a plurality of participants (see page 3, 2nd paragraph, in combination with page 1, 2nd paragraph)

- sending a message from a terminal used by a first of the participants to terminals, used by the or each other participants containing a cost sharing request (see in particular page 3, 3rd paragraph); and

- at the or each other terminal receiving said message, processing the request using predefined cost sharing rules and/or receiving user inputs relating to the request (see page 3, 3rd paragraph), and sending a response message to first participant's terminal containing a result, (see page 3, 3rd paragraph),

- the participants being charged by the network(s) (see page 5, 2nd. paragraph) in accordance with the formula.

It should be noticed that Andreas fails to clearly teach the features of:

a) the method is based upon the Session Initiation-Protocol (SIP), and
b) the step of configuring one or more-Session Initiation Protocol servers to intercept Session Initiation Protocol messages for the purpose of determining the negotiated cost sharing formula.

However, Brown et al. ("Brown") teaches such features in paragraphs [0062]-[0063], [0118]-[0119], [0122], [0149] and [0151].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of the features of a). and b). above, as taught by Brown into view of Andreas in order to provide the actual determined charge towards each party.

Regarding claim 15-20, Andreas further teaches the limitations of the claims as followings:

In combination with the features of any claim to which they refer, involve the subject-matter of said claims is either in principle derivable from the disclosure of *Andreas* reference (for claim 3: response to cost sharing proposal, see in particular page 3, 3rd paragraph, 3rd and 4th - sentences; for claim. 4; receiving terminal, proposes alternative or modified cost proposal:

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see in particular page 6, 3rd paragraph; for claim 5" three or more participants: implied by page 1, 2nd paragraph, 2nd sentence; and by page 6, 2nd paragraph, last sentence "bilateraler oder multilateraler Abkommen"; for claim 6, time of negotiation: see in particular page. 3, 2nd paragraph, 2nd sentence [see also D2, page 6, lines 1 to 7]; for claim 7: 3GPP IP Multimedia Subsystem: implied by Page 1, 2nd paragraph "Multimedia Session"; for claim 9: a mobile wireless terminal being implied by the 3GPP standard mentioned in Andreas) reference or of (for claim 2: either calling or called party is permitted to start the '403 reference) service for reverse charging, the invocation principle being obviously also applicable for the negotiation: see page 3, line 26 to page 4, line 12 and page 6, lines 1 to 7) represents simple design details which are generally known to the person skilled in the field of Multimedia services and its related charging.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh K. Tieu whose telephone number is (571) 272-7510 and E-mail address: BINH.TIEU@USPTO.GOV.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz, can be reached on (571) 272-7499 and **IF PAPER HAS BEEN MISSED FROM THIS OFFICIAL ACTION PACKAGE, PLEASE CALL CUSTOMER SERVICE FOR THE SUBSTITUTIONS OR COPIES.**

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/BINH K. TIEU/
Primary Examiner
Technology Division 2614

Date: July 2007